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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,334	09/25/2001	Sachin Desai	50277-1764 (OID 2001-054-	2898
29989	7590	06/16/2004	EXAMINER	
HICKMAN PALERMO TRUONG & BECKER, LLP 1600 WILLOW STREET SAN JOSE, CA 95125			DAS, CHAMELI	
			ART UNIT	PAPER NUMBER

2122

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,334	<b>Applicant(s)</b> DESAI, SACHIN	
	<b>Examiner</b> C.DAS	<b>Art Unit</b> 2122	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,10,11,16-21,34,35,43,44,47 and 49-54 is/are rejected.
- 7) ☒ Claim(s) 3-9,12-15,22-33,36-42,45,46,48 and 55-65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-65 are pending.

#### ***Specification***

2. The use of the trademarks "Java" and "Java Virtual Machine" have been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21, 32, 54 and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21, 32, 54 and 65 contain the trademark/trade name "Java". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is

used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "compiled instructions" and, accordingly, the identification/description is indefinite.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1- 2, 10-11, 16-18, 20-21, 34-35, 43-44, 47, 49-51, 53-54 are rejected under 35 U.S.C. 102(a) as being anticipated by Tock et al, (Tock), US 6,128,771

***As per claims 1, 34, Tock discloses:***

- a method of automatically modifying behavior of a compiled program  
(Abstract, lines 1-4, col 2, lines 16-27)
- receiving a first set of compiled instructions to generate a modified set of compiled instruction (col 3, lines 44-49)
- inserting into said first set of compiled instruction a new set of one or more instruction for invoking a modification routine that provides new behavior (col 10, lines 3-37, col 1, lines 6-12, col 14, lines 30-40)
- wherein the modification routine is not part of the first set of compiled instructions (col 3, lines 46-50 and Fig 3).

***As per claim 2, Tock discloses:***

- executing a runtime module based on the modified set of compiled instructions (col 4, lines 18-24).

***For claims 10, 43,*** (col 2, lines 23-28).

***For claims 11, 44, 47,*** (col 8, lines 26-44).

***For claims 16, 49,*** (col 8, lines 45-50)

***For claims 17, 50*** ( col 15, lines 34-60).

***For claims 18, 51,*** (col 5, lines 59-64).

***For claims 20, 53,*** (col 6, lines 46-57).

***For claims 21, 54,*** (col 3, lines 24-26)

***For claim 35,*** (col 4, lines 18-24).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19, 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tock et al, US 6,128,771 and further in view of the official notice.

***For claims 19, 52,*** Tock does not specifically disclose the method of indicating a number of times the compiled instructions are executed. However, the official notice is taken for indicating the number of times the compiled instructions are executed. The

modification would be obvious because one of the ordinary skill in the art would be motivated to monitor the performance of a compiled program efficiently.

***Allowable Subject Matter***

7. Claims 3-9, 12-15, 22-31, 33, 36-42, 45-46, 48, 55-64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 32 and 65 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

TITLE: Instrumentation and optimization tools for heterogeneous programs, US 6481008 B1

TITLE: Object code logic analysis and automated modification system and method, US 6071317 A

TITLE: Method for target-specific development of fixed-point algorithms employing C++ class definitions, US 6460177 B1

TITLE: Method and apparatus for introducing program changes in program-controlled systems, US 4425618 A

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TITLE: Method and apparatus for dynamic management of translated code blocks in dynamic object code translation, US 6529862 B1.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chameli Das whose telephone number is 703-305-1339. The examiner can normally be reached on Monday-Friday from 7:00 A.M. to 3:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Tuan Dam can be reached at 703-305-4552. The fax number for this group is: (703) 872-9306.

An inquiry of general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is 703-305-9600.



**CHAMELI C. DAS**  
**PRIMARY EXAMINER**

6/8/04

**BEST AVAILABLE COPY**